

REMARKS

Claims 1 and 4-21 are presented for examination. Claims 1 and 4-11 are allowed.

Claims 12-17, 19 and 20 have been rejected under 35 U.S.C. 102(e) as being anticipated by Daines et al. Dependent claims 18 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Daines et al. in view of Joung et al. These rejections are respectfully traversed for the following reasons.

Anticipation, under 35 U.S.C. § 102, requires that each element of a claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference.

*Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1920 (Fed. Cir. 1989) *cert. denied*, 110 S.Ct. 154 (1989). The term “anticipation,” in the sense of 35 U.S.C. 102, has acquired the accepted definition meaning “the disclosure in the prior art of a thing substantially identical with the claimed invention.” *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978). The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). To satisfy this burden, therefore, each and every element of the claimed invention must be shown by the Examiner to be disclosed in the reference. Applicant respectfully asserts that the record fails to meet this requirement.

**Independent claim 12** recites a network interface device for providing an interface between a data network and a computer system, the network interface device comprising:

- a descriptor management unit for managing receive descriptors pointing to receive buffers allocated to receive data from the network medium, and

- an automatic flow control mechanism for automatically performing flow control in accordance with the number of available receive descriptors pointing to the receive buffers available for receiving data from the network medium.

**Independent claim 19** recites a method of automatic flow control in a network interface between a data network and a computer system. The method comprises the steps of:

- monitoring the number of receive descriptors pointing to buffers in the computer system available for receiving data from the network, and

- automatically requesting a remote station in the data network to suspend data transmission when the number of receive descriptors falls below a first preprogrammed threshold level.

The Examiner relies upon col. 6, lines 58-62 for disclosing the claimed descriptor management unit. Considering the reference, Daines discloses a flow control mechanism including a level indicator indicating the amount of data stored in the buffer. Preset high and low threshold levels define the maximum data level and a “restart” level (col. 6, line 58 to col. 7, line 4).

Hence, the reference does not expressly disclose the claimed descriptor management unit for managing receive descriptors pointing to receive buffers allocated to receive data from the network medium.

Based on the definition of descriptors as “a piece of stored information used to describe something else...”, the Examiner takes the position that “the function of a descriptor is inherent.”

However, it is respectfully submitted that the claims specifically recite receive descriptors pointing to receive buffers allocated to receive data from the network medium (claim 12), and receive descriptors pointing to buffers in the computer system available for receiving data from the network (claim 19).

The Examiner is respectfully reminded that inherency requires certainty, not speculation.

*In re Rijckaert*, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324,

231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

However, the Examiner provides no factual basis upon which to conclude that Daines discloses specific descriptors recited in claims 12 and 19, and means for their management.

Further, the Examiner considers flow control device 25 of Daines to correspond to the claimed automatic flow control mechanism for automatically performing flow control in accordance with the number of available receive descriptors pointing to the receive buffers available for receiving data from the network medium.

The flow control device 25 of Daines monitors the level indicators for each buffer to determine if the amount of data stored therein exceeds a threshold level (col. 7, lines 6-9). One skilled in the art would understand that this flow control mechanism does not involve automatically performing flow control in accordance with the number of available receive descriptors pointing to the receive buffers available for receiving data from the network medium (as claim 12 requires), or monitoring the number of receive descriptors pointing to the available receive buffers, and automatically requesting a remote station in the data network to suspend data transmission when the number of receive descriptors falls below a first preprogrammed threshold level (as claim 19 recites).

As the flow control mechanism of Daines does not involve the claimed elements and steps, one skilled in the art would have no reason to conclude that the claimed invention is inherently present in the Daines teaching.

Hence, Daines neither expressly nor inherently discloses the subject matter of claims 12 and 19. Dependent claims 13-18, 20 and 21 are defined over the prior art at least for the reasons presented above in connection with claims 1 and 12.

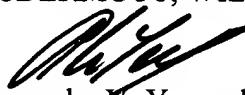
Therefore, Applicant, respectfully submits that the rejections of claims 12-21 are untenable and should be withdrawn.

In view of the foregoing, and in summary, claims 1 and 4-21 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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